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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 09/547,397 | 04/11/2000 | Hiroshi Satomi | 862.C1898 | 4943 |
| 5514 | 7590 | 12/08/2004 | EXAMINER | |
| FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | LIANG, GWEN | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2162 | |

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/547,397 | SATOMI ET AL. | |
| | Examiner | Art Unit | |
| | GWEN LIANG | 2162 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>11292004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment, filed on 6/4/2004 and Request for Continued Examination (RCE) filed on 7/28/2004. Claims 39-46 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 41 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The following claimed limitations in the claim are not sufficiently supported in the specification:

Regarding claim 41, the claimed limitation "said second search step is executed when a printing output is instructed" is not supported by the applicant's specification. For example, in the specification, page 45, lines 12-14, the disclosure "When a print instruction is received from the P service terminal 100, print data is generated and transmitted to the P service terminal 100." does not support the claimed limitation of search being executed when a printing is indicated.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 39-43, 45, 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding independent claims 39 and 43, the claimed subject matter "An information providing method", "An information providing apparatus" in the preamble renders the claims indefinite because it is unclear what type of information is being provided.

Regarding independent claims 39, 43 and 44, the claimed subject matter "the first information" in the third limitation renders the claims indefinite because there is "first information" in the first limitation and the second limitation respectively and therefore it is unclear which "first information" is considered to be its antecedent.

Regarding dependent claims 45, the claimed "said second search step is executed in consideration of the first keyword and the second keyword..." goes beyond the scope claimed in its parent claim (39), wherein "a second step ... based on the first keyword" is claimed.

Claim 46 is similarly rejected based on the reasons given for claim 45.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 39-43, 45, 46 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106 IV.B.2.(b)

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

Claims 39-42, 45, 46 in view of the above cited MPEP sections, are not statutory because they merely recite a number of manipulating steps without producing any tangible result and/or being limited to a practical application within the technological arts. The use of a computer has not been indicated.

Claim 43, in view of the above cited MPEP sections, is not statutory because it merely recites a number of functioning units without producing any tangible result and/or being limited to a practical application within the technological arts. The use of a computer has not been indicated.

Response to Arguments

7. Applicant's arguments with respect to claim 39 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 39-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Bowman et al., "Bowman" (U.S. Patent No. 6,006,225).

With respect to claim 39, Bowman discloses an information providing method ... comprising:

a first storing step, of storing a code, first information corresponding to the code and a keyword associated with the first information to a first database (Abstract and col. 2, line 47 – col. 3, line 5);

a first search step of searching in the first database for first information corresponding to an inputted code (Figure 9, wherein "OUTDOOR TRAIL" is equivalent to an inputted code);

an obtaining step, of obtaining a first keyword associated with the first information searched for in said first search step (Figure 9, wherein any of the following: "BIKE", "SPORTS" or "VACATION" is equivalent to a first keyword obtained);

a second search step, of searching for second information based on the first keyword obtained in said obtaining step (Figure 9, "Top Matches for this search"); and

an output step, of outputting the first information searched for in said first search step together with the second information searched for in said second search step (Figure 9, wherein the display includes both the first information and the second information).

Claim 40 is rejected for the reasons set forth hereinabove for claim 39 and furthermore Bowman discloses a method wherein the first keyword has a weight value, and said second search step is executed in consideration of the weight value of the first keyword (col. 12, lines 42-67).

Claim 41 is rejected for the reasons set forth hereinabove for claim 39 and furthermore Bowman discloses a method wherein said second search step is executed ... (Figure 9).

Claim 42 is rejected for the reasons set forth hereinabove for claim 39 and furthermore Bowman discloses a method wherein said second search step is executed in consideration of information of a terminal via which the user inputted the code corresponding to the first information (Figure 9).

Claim 45 is rejected for the reasons set forth hereinabove for claim 39 and furthermore Bowman discloses a method comprising:

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a second storing step, of storing a second keyword associated with a user of the first information in a second database, wherein said obtaining step further includes obtaining the second keyword, and said second search step is executed in consideration of the first keyword and the second keyword obtained in said obtaining step (col. 2, lines 31-46).

Claim 46 is rejected for the reasons set forth hereinabove for claim 39 and furthermore Bowman discloses a method comprising:

a second storing step, of storing a second keyword associated with a user of the first information with a weight value in the second database, wherein the keyword and the second keyword have weight value, and said second search step is executed in consideration of the weight value of the keyword and the second keyword (col. 12, lines 42-67).

Claims 43 and 44 are rejected on grounds corresponding to the reasons given above for claim 39.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GWEN LIANG whose telephone number is 571-272-4038. The examiner can normally be reached on 9:00 A.M. - 5:30 P.M. Monday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN BREENE can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

G.L.
6 December 2004


SHAHID ALAM
PRIMARY EXAMINER